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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92050789
Party	Defendant Hewlett-Packard Development Company, L.P.
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Attachments	RESPONDENT's REPLY ISO MOT TO SUSPEND & OPP TO MOT TO COMPEL.pdf (10 pages)(494363 bytes)

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

NARTRON CORPORATION,

Petitioner,

v.

HEWLETT-PACKARD DEVELOPMENT
COMPANY, L.P.,

Respondent.

Cancellation No. 92050789

Registration No. 3,600,880

Registration Date: April 7, 2009

Mark: TOUCHSMART

RESPONDENT HEWLETT-PACKARD
DEVELOPMENT COMPANY, L.P.'S
COMBINED REPLY IN SUPPORT OF ITS
MOTION TO SUSPEND PROCEEDINGS
AND OPPOSITION TO PETITIONER'S
MOTION TO COMPEL

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1 RESPONDENT'S COMBINED REPLY IN SUPPORT OF ITS MOTION TO SUSPEND
2 AND OPPOSITION TO PETITIONER'S MOTION TO COMPEL

3
4 **INTRODUCTION**

5 In this cancellation proceeding, Petitioner Nartron Corporation ("Nartron") seeks to compel
6 Respondent Hewlett-Packard Development Company, L.P. ("HP") to engage in irrelevant and
7 unnecessary discovery while HP's potentially dispositive motion for summary judgment remains
8 pending. This runs contrary to the Board's ordinary practice and basic principles of efficiency and
9 economy. Because the motion for summary judgment relies solely on the respective registrations of
10 Nartron and HP, fact discovery is not germane to the issues currently before the Board.
11 Accordingly, there is good cause to suspend discovery while HP's motion for summary judgment is
12 pending. The Board, in accordance with its standard procedures, should suspend all discovery and
13 other proceedings not germane to HP's motion for summary judgment, and deny Nartron's motion
14 to compel.

15
16 **ARGUMENT**

17 **I.**

18 **THE BOARD SHOULD SUSPEND ALL PROCEEDINGS**
19 **UNRELATED TO HP'S MOTION FOR SUMMARY JUDGMENT AS**
20 **OF THE DATE THAT MOTION WAS FILED.**

21 When any party files a motion for summary judgment, "the case will be suspended by the
22 Trademark Trial and Appeal Board with respect to all matters not germane to the motion and no
23 party should file any paper which is not germane to the motion except as otherwise specified in the
24 Board's suspension order." 37 C.F.R. §2.127(d); *see also* Trademark Trial and Appeal Board
25 Manual of Procedure ("TBMP") §528.03 ("When a party files a timely motion for summary
26 judgment, the Board will suspend proceedings in the case with respect to all matters not germane to
27 the motion"). While the filing of a summary judgment motion does not automatically suspend the
28 case, the parties are "presumed to know that the filing of a potentially dispositive motion will result
 in a suspension order." *Leeds Technologies Ltd. v. Topaz Commc'ns Ltd.*, 65 U.S.P.Q.2d 1303,

1 1305-06 (TTAB 2002). Accordingly, “the filing of such a motion generally will provide parties
2 with good cause to cease or defer activities unrelated to the briefing of such motion.” *Id.*

3 When the Board issues a suspension order, it “ordinarily treats the proceeding as if it had
4 been suspended as of the filing date of the potentially dispositive motion.” TBMP §510.03(a). In
5 *Leeds*, the opposer moved to suspend the proceedings pending disposition of its motion for
6 judgment on the pleadings. The applicant argued that the opposer’s failure to timely serve its
7 discovery responses after the filing of the motion for judgment on the pleadings was an act of bad
8 faith, asserting that “without waiting for a ruling from the Board, opposer’s counsel ‘unilaterally
9 decided not to answer the outstanding discovery requests.’” 65 U.S.P.Q.2d at 1305. Although the
10 Board had not officially suspended the proceedings at the time the opposer’s discovery responses
11 were due, the Board considered the proceedings suspended *retroactive* to the date the opposer filed
12 its motion for judgment on the pleadings. *Id.* at 1306.

13 Retroactive application of the suspension order is consistent with the policies underlying
14 summary resolution procedures. “The purpose of the motion [for summary judgment] is judicial
15 economy, that is, to avoid an unnecessary trial where there is no genuine issue of material fact and
16 more evidence than is already available in connection with the summary judgment motion could not
17 reasonably be expected to change the result in the case.” TBMP §528.01; *see also Pure Gold, Inc.*
18 *v. Syntex (U.S.A.), Inc.*, 739 F.2d 624, 626 (Fed. Cir. 1984) (same) (quoting *Exxon Corp. v. Nat’l*
19 *Foodline Corp.*, 579 F.2d 1244, 1246 (CCPA 1978)). Indeed, the practice of “routinely disposing of
20 numerous cases on the basis of cross-motions for summary judgment has much to commend it. . . .
21 Too often [the court] see[s] voluminous records which would be appropriate to an infringement or
22 unfair competition suit but are wholly unnecessary to resolution of the issue of registrability of a
23 mark.” *Pure Gold*, 739 F.2d at 627 n.2.

24 Here, after submitting its initial disclosures, HP moved for summary judgment exclusively
25 on the basis of the parties’ respective registration statements and facts of which the Board may take
26 notice. HP also moved pursuant to 37 C.F.R. §2.127(d) to suspend all matters not germane to the
27 motion for summary judgment. There is no reason for the Board to deviate from its ordinary
28 procedures here. *See* TBMP §528.03 (following the filing of a summary judgment motion, “the

1 Board will suspend proceedings in the case with respect to all matters not germane to the motion”);
2 37 C.F.R. §2.127(d) (same); TBMP §510.03(a) (suspension order ordinarily applies retroactively);
3 *Leeds*, 65 U.S.P.Q.2d at 1305-06 (applying suspension order retroactively).

4 Nartron’s reliance on *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 U.S.P.Q. 955
5 (TTAB 1986), is misplaced. In that case, the Board held that the filing of a motion for summary
6 judgment did not excuse the applicant from complying with outstanding discovery requests where
7 the applicant did not file an answer; filed three separate motions for summary judgment, all of which
8 the Board deemed to be frivolous; filed its own motion to compel discovery *after* it had already filed
9 two motions for summary judgment; refused to respond to the opposer’s discovery requests until it
10 first received what it deemed to be satisfactory responses to its own requests; made no mention of
11 the summary judgment motion when conferring with opposing counsel about discovery; and did not
12 file a motion to suspend or to extend time to respond to the discovery requests in light of its
13 summary judgment motions. *Id.* at 965-68.

14 The Board determined that “*in the circumstances of this case*, the pendency of applicant’s
15 first motion for summary judgment does not constitute good cause for not timely responding to
16 opposer’s outstanding discovery requests.” *Id.* at 966 (emphasis added). Indeed, the Board
17 remarked that “[t]he fact of such pendency . . . appears to have been a convenient afterthought to
18 applicant’s counsel, who apparently never mentioned the matter during the telephone conference
19 with opposer’s attorney.” *Id.* Under such circumstances, it was “clear that rather than acting in
20 accordance with a sincere belief that the filing of the first motion for summary judgment should
21 operate to stay responses to opposer’s discovery requests, applicant’s counsel was not acting in good
22 faith” *Id.*

23 *Giant Food* is not instructive under the circumstances presented here, which have little in
24 common with the facts of that case. HP duly filed an answer, timely moved for summary judgment
25 and to suspend all proceedings unrelated to the motion, including discovery, and refrained from
26 propounding any discovery requests of its own. In addition to filing a motion to suspend, HP
27 communicated its position to Nartron during the meet-and-confer process, explaining its belief that
28 all other matters should be suspended pending resolution of the summary judgment motion. As the

1 Board recognized in *Giant Food*, “in certain circumstances, the filing of a motion for summary
2 judgment may serve as good cause for not responding to discovery requests.” *Giant Food*, 229
3 U.S.P.Q. at 965-66; *see also Leeds*, 65 U.S.P.Q.2d at 1305-06 (the filing of a dispositive motion
4 provides good cause “to cease or defer activities unrelated to the briefing of such motion”); TBMP
5 §528.03 (“on a case-by-case basis, the Board may find that the filing of a motion for summary
6 judgment provides a party with good cause for not complying with an otherwise outstanding
7 obligation, for example, responding to discovery requests”). Such is the case here.

8 The Board should suspend discovery and all other deadlines and proceedings in this matter
9 except for the pending motion for summary judgment effective September 30, 2009, the date HP
10 filed its summary judgment motion.

11 II.

12 13 **NARTRON’S MOTION TO COMPEL SHOULD BE DENIED** 14 **BECAUSE THE DISCOVERY IT SEEKS IS UNRELATED TO HP’S** 15 **MOTION FOR SUMMARY JUDGMENT AND IS THEREFORE** 16 **SUBJECT TO SUSPENSION.**

17 Nartron offers only two examples in support of its argument that its discovery requests are
18 germane to HP’s summary judgment motion. It points to (a) discovery requests on the issue of
19 intent, and (b) HP’s purported failure to refute certain evidence presented by Nartron. The latter has
20 nothing to do with discovery; it is an argument in opposition to summary judgment.¹ The former is
21 similarly unpersuasive. Nartron requested the production of HP’s search reports, which Nartron
22 believes are “probative of HP’s intent in selecting and adopting TOUCHSMART.” Opp. 3-4.
23 Nartron argues that such evidence is necessary to the Board’s consideration of the *duPont* factors on
24 summary judgment. But for purposes of HP’s summary judgment motion, the issue of intent—and
25 any corresponding discovery—is irrelevant.

26 ¹Nartron’s assertion that HP has “fail[ed] to address key evidence of record in this
27 proceeding” (Petitioner’s Combined Brief In Opposition To Respondent’s Motion To Suspend And
28 In Support Of Petitioner’s Motion To Compel (“Opp.”) 4), though meritless, properly should be
raised in Nartron’s opposition brief. It has no bearing on whether Nartron’s discovery requests
should be subject to a suspension order.

1 HP has moved for summary judgment exclusively on grounds that require no additional
2 discovery. Nartron has alleged that the marks and goods described in the parties' respective
3 registrations are closely related and likely to cause confusion among consumers. The registrations—
4 together with facts of which the Board may take notice—are sufficient to demonstrate that the marks
5 at issue are dissimilar, and that the claimed goods at issue are substantially different, would typically
6 travel in different channels of trade, and would typically be purchased with a high degree of care.
7 The Board may grant summary judgment if it finds that these factors are dispositive. *See Kellogg*
8 *Co. v. Pack'Em Enters. Inc.*, 951 F.2d 330, 332-33 (Fed. Cir. 1991) (single *duPont* factor of
9 dissimilarity of marks outweighed all others such that the other factors, even if decided in
10 nonmovant's favor, would not be material because they would not change the result). In other
11 words, even if the Board were to find that the issue of intent were relevant, the factors analyzed in
12 HP's motion would still mandate summary judgment in favor of HP.

13 Additional discovery and "voluminous records" will not change the issue presented on
14 summary judgment or the result; the Board already has all of the material facts before it. As a
15 matter of law, the "relatedness of the goods" "must be decided on the basis of the identification of
16 goods or services set forth in the application, regardless of what the record may reveal as to the
17 particular nature of applicant's goods, the particular channels of trade, or the class of purchasers to
18 which sales of the goods or services are directed." *Packard Press Inc. v. Hewlett-Packard Co.*, 227
19 F.3d 1352, 1359 (Fed. Cir. 2000). There is no reason for the Board to examine additional facts that
20 cannot reasonably be expected to alter the result. *See* TBMP §528.01 ("[A] dispute over a fact that
21 would not alter the Board's decision on the legal issue will not prevent entry of summary
22 judgment"); *Pure Gold*, 739 F.2d at 626-27 (upholding grant of summary judgment against plaintiff
23 in part on the grounds that "the additional evidence [plaintiff] suggests it might be able to obtain
24 would not change the legal conclusion of no likelihood of confusion").

25 Accordingly, discovery should be suspended pending resolution of HP's motion for
26 summary judgment. Should the Board should deny the motion, HP will respond to Nartron's
27 pending discovery by a reasonable date after resumption of the proceedings. *See* 37 C.F.R.
28 §2.127(d) ("If the case is not disposed of as a result of the motion, proceedings will be resumed

1 pursuant to an order of the Board when the motion is decided"). Because discovery is unnecessary
2 at this time to resolve HP's summary judgment motion, and because HP has demonstrated good
3 cause for its lack of response to Nartron's discovery requests, the Board should deny Nartron's
4 motion to compel.

5
6 **CONCLUSION**

7 For the foregoing reasons, the Board should grant HP's motion to suspend, suspend
8 discovery and all other deadlines and proceedings in this matter effective September 30, 2009, and
9 deny Nartron's motion to compel.

10 DATED: November 9, 2009.

11
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Date of Deposit and eFiling with the TTAB: November 9, 2009

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I declare under penalty of perjury under the laws of the State of California that the foregoing is true and correct, and that this Declaration is executed in San Francisco, California, this 30th day of September, 2009.

George M. Price
George M. Price

HOWARD
RICE
NEMEROVSKI
CANADY
FALK
& RABKIN

A Professional Corporation